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NELLCOR PURITAN BENNETT LLC ATTN: IP LEGAL 60 Middletown Avenue North Haven, CT 06473			WINAKUR, ERIC FRANK	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/798,596
Filing Date: March 10, 2004
Appellant(s): MANNHEIMER ET AL.

W. Allen Powell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 October 2007 appealing from the Office action mailed 15 December 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 - 7, 9 - 26, and 46 - 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed discloses that the memory stores coefficients (used in formulas) and breakpoints (used to indicate when to use a particular formula) [see originally filed Figures 2 and 3 and the descriptions thereof on pages 5 - 6 of the specification]. Further, the originally filed specification teaches that different formulas may be used for different sections of the saturation curve. However, these formulas are resident in the sensor reader/monitor. There is no teaching or suggestion that the sensor memory includes the formulas or algorithms, only that the coefficients and breakpoints are stored therein. As such, the claims contain subject matter that was not adequately described by the specification as originally filed, and therefore Applicant did not have possession of the claimed invention at the time the application was filed.

(10) Response to Argument

It is noted that Applicant's ARGUMENT section, presented on pages 5 - 10 of the Appeal Brief merely provides a summary of all of the rejections set forth in the Office

actions mailed 26 June 2006, 15 December 2006, and 2 May 2007 (Applicant provides quotations of the most relevant portions of Examiner's arguments), along with the corresponding arguments that were presented by Applicant in response thereto. Only the paragraphs beginning in the middle of page 10 to the middle of page 11 present new arguments.

To summarize, the invention is drawn to a system including a pulse oximeter sensor having a sensor memory and a pulse oximetry monitor having a monitor memory. Examiner notes that in the originally filed specification there is only a positively provided teaching of storing coefficients or breakpoints on the sensor memory (as noted in the statement of the rejection above, Figures 2 and 3 and specification pages 5 - 6 provide the most relevant details of this teaching) and it is understood from the disclosure that the pulse oximetry monitor reads the coefficients and breakpoints from the sensor memory and uses this information when calculating the oxygen saturation of a monitored subject. However, contrary to the teachings of the originally filed specification, the claims are directed to a sensor memory storing formulas.

Certain of Applicant's arguments do not appear to relate to the rejection presented above. In particular, Examiner does not contend that there is a lack of enablement of the claimed subject matter (Note Applicant's reference to *In re Wertheim*) or that the terms of the claims are inconsistent with the specification (see the reference to *Ellipse Corp. v Ford Motor Co.*). As such, these arguments are in apt. Rather, Examiner's position is that there is nothing in the originally filed specification (Applicant relies upon the teaching of the originally filed application at page 9, lines 13 - 18 in an

attempt to show support in the original specification for the claimed subject matter) that demonstrates that Applicant was in possession of the claimed subject matter at the time of the invention. This is the sole issue to resolve.

A reading and analysis of page 9, lines 13 - 18 will lead to the conclusion that this disclosure does not provide a teaching of the sort that Applicant contends. The statement that "any function can be used for the formulas for determining oxygen saturation, not just the ones described" must be taken for its plain meaning in the context of the specification. Namely, that at the time of the invention, Applicant was aware that alternative functions and formulas for determining oxygen saturation than those they discussed within their specification were known and applicable for inclusion in their inventive concept. Further, Applicant was aware that development of new formulas that may have been faster or more accurate, most likely would occur, but would also likely be of a format for implementation with the disclosed inventive concept. As a reminder, the invention concerns storing the formula/function on the monitor memory and storing coefficients/breakpoints to be used in the formula on the sensor memory. There is no possible interpretation of this sentence (particularly when interpreted in light of the remainder of the specification) to suggest that it is a teaching of storing the formulas on the sensor memory, as required by the claims.

The paragraph continues with the statement that, "For a limited sensor memory, the function representation may be compressed. Any representation of a function could be used." Although Applicant argues that these sentences show possession of the claimed subject matter (they are the only sentences in the entire specification that could

remotely be interpreted in this manner), Applicant's position is not supported by the remainder of the specification, which clearly sets forth that the sensor memory is for storing coefficients and breakpoints, not formulas. Further, one must remember that the parent application was filed in 2001 with a priority claim to April 2000. At that time, digital memory was much more expensive per byte than at the present time. Therefore, including a memory in a sensor that would be discarded after use by one or only a few patients could add significantly to the cost of the sensor. Thus, while Applicant's concern with dealing with the problems of a limited sensor memory may not be as relevant today due to reduced cost of digital memory elements, this sentence must be interpreted with thought of the time in which it was written. As Examiner noted at page 3 of the Final rejection of 15 December 2005, one can only conclude that these sentences are pointing to a manner to take advantage of more complex formulas while using a sensor with limited memory capacity. Proper compression (Applicant gives one example of a manner to reduce the amount of data needed to be stored in the paragraph bridging pages 2 - 3 of the originally filed specification) of the function representation would allow one to take advantage of more complex functions without overburdening the sensor memory with coefficients beyond the capacity of the limited memory or requiring implementation with a cost-prohibitive memory.

Applicant's newly presented arguments (see middle of page 10 - 11) do not overcome Examiner's previously presented arguments. Applicant's first point merely reiterates the previously addressed arguments. The second point ("one of ordinary skill in the art would understand how to compress the function representation ... for more

efficient storage on a limited memory") appears to argue that the claims are enabled; however, the claims are not rejected as lacking enablement. Applicant's final position, that there is not any support for limiting the scope of the present application to storing formulas/functions only on a monitor, is contrary to the written description requirement of 35 USC 112, first paragraph.

As discussed above, none of Applicant's arguments demonstrate possession of the claimed invention at the time of filing of the instant application and in fact, a review of the specification as originally filed shows that there is no explicit, inherent, or suggested teaching of the claimed subject matter. As such, Examiner's rejection is proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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